



UNITED STATES DEPARTMENT OF COMMERCE
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MF	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
	09/476,877	01/03/00	AUSUBEL	L 3788-7004

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TM02/0412

EXAMINER

POINVIL, F

ART UNIT	PAPER NUMBER
2164	8

DATE MAILED: 04/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademark

Office Action Summary

Application No.
09/476,877

Applicant(s)
AUSUBEL

Examiner
Frantzy Polinvil

Group Art Unit
2164



☒ Responsive to communication(s) filed on Nov 8, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 53-86 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 53-54, 57, 60, 61, 64-67, 71-75, 78-79, and 81-86 is/are rejected.

☒ Claim(s) 55-56, 58-59, 62-63, 68-70, 76-77, and 80 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 53, 54, 57, 60, 61, 64-67, 71-75, 78-79 and 81-86 remain rejected under 35 U.S.C. 103(a) as being unpatentable over ONSALE publication as stated in the prior Office action..

Applicant's representative states that the ONSALE publication does not disclose that the continuation of an auction is based on bids, signals or bid information and argues that the publication fails to teach or suggest a "decision means responsive to the bid information in determining whether or not an auction should continue or terminate".

In response, in most auction systems, bids on an item are usually set for a predetermined duration or time and a winner may be declared based on time or based on the highest placed bid. Likewise, the ONSALE publication clearly teaches that in a standard auction, items are placed for a fixed period of time and sold to the highest bidder. An auction ends or continues depending on the lowest successful bidder's price. See page 2, fifth paragraph of the article.

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Applicant's representative then argues that the determination of whether to continue or terminate the "Dutch auction" and "Mark-down auction" is not disclosed at all.

In response, applicant is directed to page 2, fifth paragraph of the article. Moreover, Dutch auction and Markdown types auctions are well known types of auction systems. Their functioning are well known to the skilled artisan. Applicant is directed to *In re Bozek*, 163 USPQ 545 (CCPA 1969) which stated "Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from **common knowledge and common sense** of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

Applicant's representative then argues that the Office action fails to indicate the rationale for stating the auction of "television licences or associated derivatives rights" is obvious.

In response, the Examiner had clearly indicated that ONSALE is directed to an auction system which includes a standard, Dutch or Markdown type auction. Buyers and sellers bid on many different types of merchandises. The only difference between the instant invention and the ONSALE system is on the type of products/services being auctioned. Here, the Examiner had taken the position that it matters not as to the types of goods/services being offered. What is of importance is the functioning of the overall system of the instant claims. The Examiner notes that both the instant invention and the ONSALE system functions in a very similar manner with the exception of the types of goods/services being offered. The kinds/types of items being auctioned do not affect the functioning of the ONSALE system as these are merely types of data having no

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meaningful effect to the functioning of the auction system. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to auction any types of goods/services in the ONSALE system as would have been desired to an auctioneer since no meaningful changes to the functioning of the overall system would have been necessitated.

Applicant's representative then argues that the Examiner has not formulated a proper motivation for the obviousness rationale and requests some indication of whether the obviousness is based on the references, the nature of the problem being solved or the knowledge of persons skilled in the art and any basis for that assertion.

In response, applicant is directed to the above response. The Examiner's assertion is based on the references and on the knowledge of persons skilled in the art. It would have been obvious to a person skilled in the art when gleaning at the ONSALE publication would have been motivated to also use the system when attempting to auction a particular good/service so as to make the particular good/service available as auction items to a plurality of remote buyers/sellers.

Applicant's representative the argues claims 54, 61, 68, 75, 83 and 86 specify that the bid information includes a value parameter and an associated license subset identification which call for determining whether or not the auction should continue.

In response, ONSALE teaches that a user must submit bid information such as a price (payment) in relationship with the item being auctioned. See pages 1-2 of the article.

As per claims 57-58, 64-65, 71-72, 78-79, 82 and 85, many different types of auctions are known to be conducted in multiple rounds. It would have been obvious to one of ordinary skill in

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the art at the time of the invention was made to conduct a multiple round auction in the ONSALE system in order to allow bidders to submit new bid offers.

Applicant's representative then argues that there is no indication in the ONSALE system that messages are involved and no indication of two different types of messages.

In response, the ONSALE system is an interactive system which transmits bid information to customers and bidders may choose to respond by increasing their bids. Thus from these information it would have been obvious to note that if customers are transmitting bids the auction does not yet end.

3. Claims 55-56, 58-59, 62-63, 66, 68-70, 76-77 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

FP

07Apr01


Frantzy Poinvil
Primary Examiner
Art Unit 2164